

Remarks

Applicants thank the Examiner for participating in the Examiner Interview of January 6, 2011 with Applicants' attorney, during which the parties discussed potential amendments to the claims. Claims 16, 18-20 and 24-31 are pending and are rejected under 35 U.S.C. § 103(a). Claims 29 and 32-31[sic] are provisionally rejected under 35 U.S.C. § 101. Claims 16 and 29 have been amended. Support for the amendments can be found, at least at, page 7, lines 1-14 of the originally-filed Specification. For the reasons stated below, Applicant respectfully requests reconsideration and withdrawal of the rejections to the claims.

1. DOUBLE PATENTING

The Office action states claims 29 and 32-31 [sic] are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 22-25 of copending Application No. 12/393,931. Claims 32-34 of this application were previously cancelled. Claim 22 of copending Application No. 12/393,931 was previously cancelled. Applicants submit claims 29 and 31 of this application are not identical to claims 23-35 of copending Application No. 12/393,931. Applicants respectfully request the double patenting rejection be withdrawn.

2. REJECTION OF CLAIMS UNDER 35 U.S.C. § 103(a)

Claims 16, 18-20 and 25-31 stand rejected under 35 U.S.C. § 103(a)

Claims 16, 18-20 and 25-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,392,779 to Meredith et al. ("Meredith") in view of U.S. Patent No. 6,161,046 by Maniglia et al. ("Maniglia"). For a rejection to be proper under 35 U.S.C. §103(a), the cited references, either alone or in combination, must teach or suggest every element of the claimed invention. For the reasons stated below, Applicant respectfully submits that neither Meredith nor Maniglia, either alone or in combination, teach or suggest every element of Applicant's claimed invention.

Regarding claims 16, 18-20, 25-28 and 30-31

Claim 16 recites, in part:

"a testing apparatus comprising an electromagnetic field generator for exciting the member and comprising detecting means for detecting at least one resonance frequency of the member when it is attached to the implant", and

“wherein said member comprises a magnetic part and said testing apparatus detecting means comprises an electromagnetic detector for contactless detection of said magnetic part.”

Applicants submit neither Maniglia nor Meredith teach at least these elements of the claimed invention. The Office action states Maniglia teaches a “disposable implant member 36 comprising a magnetic detectable part having a (titanium) coil releasably connected to a bone 24”; and a probe portion comprising an electromagnetic detector (i.e., coil) (see fig. 4; col. 5, lines 45-49; col. 6, lines 8-10, 13-16 & 51-57.” (Note: the Office action states Meredith lacks a member comprising a magnetic part or a coil; or a detector comprising an electromagnetic part of a magnetic part). Applicants respectfully submit Maniglia teaches (and the components identified in the Office action are components of) a microphone, as explained in Applicants previous remarks. Maniglia does not teach a testing apparatus comprising an electromagnetic field generator for exciting the member and comprising detecting means for detecting at least one resonance frequency of the member when it is attached to the implant.”

Applicants also submit Meredith does not remedy the deficiencies of Maniglia. Applicants submit Meredith does not teach, at least, an electromagnetic field generator for exciting the member, nor does Meredith teach an electromagnetic detector for contactless detection of a magnetic part of the member.

In addition, Meredith and Maniglia are directed to two different applications. Neither Meredith nor Maniglia teach or suggest that a microphone could be used for such purposes. Applicants submit it would not have been obvious to one of ordinary skill in the art to combine (nor is there a motivation to combine) the teachings of Meredith and Maniglia. Applicants also submit the two references do not teach or suggest how the elements of Meredith could be combined with the elements of Maniglia to achieve the desired result. Accordingly, Applicants respectfully submit neither Meredith nor Maniglia, either alone or in combination, teach or suggest every element of Applicant’s claimed invention.

For, at least, the reasons stated above, Applicants submit that claim 16 is in condition for allowance. Claims 18-20, 25-28, and 30-31 depend, directly or indirectly, from claim 16. For

the same reasons as stated above with respect to claim 16, Applicants submit claims 18-20, 25-28, and 30-31 also are in condition for allowance.

Regarding claim 29

Claim 29 recites:

“A disposable implant testing part provided for testing an implant attached to a bone, said part comprising a detectable part, which can be excited by a electromagnetic field generator of the testing apparatus and detected contactlessly by a detector of the testing apparatus.”

Applicants submit neither Meredith nor Maniglia teach or suggest the elements of claim 29 for the same reasons described above with respect to claim 16. Accordingly, Applicants submit that claim 29 is in condition for allowance.

Claim 24 stands rejected under 35 U.S.C. § 103(a)

Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Meredith in view of Maniglia, and further in view of U.S. Patent No. 6,583,630 to Mendes et al. (“Mendes”). For a rejection to be proper under 35 U.S.C. §103(a), the cited references, either alone or in combination, must teach or suggest every element of the claimed invention. For the reasons stated below, Applicant respectfully submits that Meredith, Maniglia and Mendes, neither alone or in combination, teach nor suggest every element of Applicant’s claimed invention.

The Office action states that Mendes describes a detectable part that consists of ferromagnetic material. Applicants submit that Mendes does not cure the deficiencies of Meredith and Maniglia. Applicants submit that Mendes does not teach or suggest, at least the following limitations of claim 16:

“a member adapted to be releasably attached to said implant; and
a testing apparatus comprising an electromagnetic field generator for exciting the member and comprising detecting means for detecting at least one resonance frequency of the member when it is attached to the implant,

wherein said member comprises a magnetic part and said testing apparatus detecting means comprises an electromagnetic detector for contactless detection of said magnetic part.”

For the reasons stated above, Applicants submit claim 24 is in condition for allowance.

CONCLUSION

Applicant’s discussion of particular positions of the Examiner does not constitute a concession with respect to any positions that are not expressly contested by the Applicant. Applicant’s emphasis of particular reasons why the claims are patentable does not imply that there are not other sufficient reasons why the claims are patentable nor does it imply the claims were not allowable in their unamended form.

In view of the foregoing remarks, Applicants respectfully submit that all claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. If the Examiner feels that a telephone conference would expedite the prosecution of this case, the Examiner is invited to call the undersigned.

If any fees are due with the submission of this Amendment and Response, the Commissioner is hereby authorized to charge the fees due to Attorney’s Deposit Account No. 50-4514.

Respectfully submitted,

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